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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/328,626	06/09/1999	STEVEN A. BOVE	245-111	7062
570	7590	01/27/2005	EXAMINER	
AKIN GUMP STRAUSS HAUER & FELD L.L.P. ONE COMMERCE SQUARE 2005 MARKET STREET, SUITE 2200 PHILADELPHIA, PA 19103-7013			FELTEN, DANIEL S	
			ART UNIT	PAPER NUMBER
			3624	
DATE MAILED: 01/27/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/328,626

Applicant(s)

BOVE ET AL.

Examiner

Daniel S Felten

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 03 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 1-62 are pending. Claims 1, 15, 30 and 44 were amended to delete new language added in the March 19, 2004 amendment. Claims 7, 9, 10, 21, 23, 24, 36, 38, 39, 50, 52 and 53 were amended to address the rejection under 35 USC § 112, second paragraph.
2. The affidavit filed on July 16, 2004 under 37 CFR 1.131 is sufficient to overcome the Wallman (US 6,161,098) reference.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moran (US 6,430,541) in view of Wallman (US 6,601,044).

Moran discloses a computerized process, product and program for automating and executing investment planning for a client comprising (see Moran, col. 17, ll. 48-62),

(a) inputting into a computer data regarding the client's desired asset portfolio, including the taxable status of each asset (see Moran, col. 18, ll. 11-14),

(b) inputting into a computer the client's desired asset allocation (see Moran, col. 18, ll. 11+);

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(c)... preferred domain (see Moran, col. 17, ll. 48-62);

(e) displaying the recommendations on a summary report for review by the client or the client's financial manager (see Moran fig. 49, col. 34, ll. 10+);

Moran discloses automatically generating financial transaction recommendations (see Moran, see fig. 54), but fails to disclose that the recommendations call for modifying the client's current asset portfolio to reach *as close as possible* to the desired asset allocation and preferred domain.

Wallman discloses modifying the client current asset portfolio based upon the clients desired allocation (see Wallman, col. 11, 66 to col. 12, 11. 11., and col. 12, lines 34-54) and taxable or tax-deferred status (i.e. 1RA, 401(k)) (see 1044, col. 13, col. 17, 34+). It would have been obvious for an artisan of ordinary skill at the time of the invention to employ Wallman providing the aforementioned feature so as to provide the client with more control over the client's desired asset allocation. Moreover it would have been obvious for an artisan of ordinary skill at the time of the invention to employ, the aforementioned features of Wallman into Moran because an artisan the time of the invention would have been motivated provide the client with control over the client's desired asset allocation accounts that have assets in a taxable or tax-deferred status as a part of the client's total portfolio. Thus such a modification would have been an obvious expedient well within the ordinary skill in the art.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S Felten whose telephone number is (703) 305-0724. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel S Felten  
Examiner  
Art Unit 3624



DSF  
January 19, 2005

VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
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